

REMARKS

Claims 28-46 are in this case.

Reconsideration of the rejection for double patenting is requested. This case has the same effective filing date as the parent case (now Patent No. 06/282,513). Therefore, any patent granted on this application will expire 20 years after said filing dated the same as in the case of applicant's prior patent.

In 1995 Congress passed a law providing that a patent expires 20 years after its effective filing date and not 17 years after grant of a patent. That law had the effect of drastically changing the rules of double patenting. The examiner is applying the old law; indeed all of the cases cited by the Examiner deal with the old law and do not apply here.

MPEP Sec. 800 makes it clear over and over again that the doctrine of double patenting applies to cases where the second patent would extend the monopoly which is not the case here. As evidence, see Rivera U.S. Patent 6,097,127 which has much the same disclosure as earlier Rivera patent 5,912,127, and indeed has broader claims than the claims of the earlier patent.

There are two types of double patenting, statutory and non-statutory (See MPEP 804.02). The MPEP states (804.02):

“A rejection based on the statutory type of double patenting can be avoided by amending the conflicting claims so that they are not coextensive in scope.”

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“A rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made.”

As for the statutory double patenting, the applicant's claims in this application are clearly "not coextensive in scope" with the claim of the patent, as the Examiner admits at page 11 line 2 and 3 of her decision.

Referring to the non-statutory form of double patenting, the MPEP Sec 804.02 makes it clear that a terminal disclaimer will avoid the rejection. But since any patent granted this application will expire on the same date as applicant's patent, a terminal disclaimer is not required.

Applicant disagrees with the Examiner's summary of Dorne at the top of page 5 of the last Office Action.

Nowhere does Dorne mention the various operations of the operator of a medical machine.

Dorne enters the final results of the use of a machine thus he might enter that an x-ray of the big toe was taken.

Nowhere does Dorne refer to or enter into a computer the various operations the technician made while taking the x-ray of the big toe for example.

Dorne makes entries in his computer before a procedure is started and after the procedure is complete. New claims 42-46 specify actions prior to completion and these overcome the references.

Dorne U.S. Patent No. 5,325,293 teaches a method for correlating medical procedures into billing codes. (Col. 3 line 19-20)

Dorne's system translates medical procedures into accurate billing codes... (Col. 3, line 22-33)

Dorne teaches an interactive program gives the user a choice of entering an examination for a new patient or recalling an examination for a previous patient. (Col. 5, line 5-8).

Dorne teaches the user interacts with the interactive program by selecting specific procedures buttons corresponding to a planned examination or a performed examination. (Col. 6, line 38-40)

Dorne's column 8, relied on by the Examiner, cites Fig. 3D of Dorne's drawings. That figure clearly shows that Dorne does not enter individual operations of the operator.

In general, Dorne's teaches an interactive program assigns one of the following statuses to each examination: PLANNED, PERFORMED, REVIEWED and BILLED. The user enters PLANNED examination on or before the date of the examination, which can commonly be done by clerical personnel based on information received from the initial appointment conversation or form an X-ray requisition. The PLANNED status allows the radiologist to keep track of future examinations and to reduce the amount of data entered after the radiologist has performed the examination. (Col. 8, line 23-33)

Dorne does not have a standard protocol about the operator or machine.

Dorne does not enter data into the computer during the actual performance of the procedure data about said procedure.

Dorne after entering a planned procedure, does not enter data into the computer concerning each image prior to each image being taken.

Dorne does not compare the standard operations with the actual performance of operations to see if there is a difference in the skill levels of the operator.

Dorne does not monitor the operations of a machine during the performance of a procedure.

Dorne does not monitor the operations of the operator during the performance of a procedure.

Wenstrup et al teaches how a machine may produce uniform results and has nothing to do with how an operator may operate the machine. There is no suggestion that there should be a standard protocol and that the actual operations of an operator should be compared to said standard protocol.

Even if the combination is made it does not meet the claims, neither Dorne nor Wenstrup et al place the individual operations of the operator of a medical machine into the computer and therefore has nothing to do with the present invention.

MPEP Sec. 2143.01 says quote:

“Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so >. *In re Khan*, 441 F.3d 977, 986, 78 USPQ2d 1329, 1335 (Fed. Cir. 2006) (discussing rationale underlying the motivation-suggestion-teaching requirement as a guard against using hindsight in an obviousness analysis). The teaching, suggestion, or motivation must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. “The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as whole would have suggested to those of ordinary skill in the art.”

MPEP Sec. 2143.03 says quote:

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royke*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” “All words in a claim must be considered in judging the patentability of that claim against the prior art.”

The claims in this case are different in scope from the claims in the parent application.

Claim 28 patentably defines over the prior art by calling for “a standard protocol,” “entering the operations of the operator” and the “comparing said standard protocol with the operations that were entered by said apparatus.”

Claim 29 is patentable as it calls for “prices computed from the operations performed by said machine.”

Claim 30 is patentable by reason of the statements in line 2 of the claim in combination with the recitals of the parent claim.

Claim 31 is patentable as it calls for the operations of the parent claim to be performed on a plurality of machines, in combination with claim 28.

Claim 32 is patentable since it calls for at least one computer for each machine.

Claim 33 is similar to claim 28, except it is in method format and is patentable for the same reasons as claim 28.

Claim 34 is patentable since it calls for computing prices in combination with the steps of claim 33.

Claim 35 is patentable since it calls for plural machines in the combination of steps of claim 33.

Claim 36 is patentable since it calls for one computer for each machine in the combination of claims 33 and 35.

Claim 37 is patentable in view of its recitals in lines 2 and 3 in combination with the steps of claims 33 and 35.

Claim 38 is patentable in view of its last three lines in combination with claim 33.

Claim 39 is patentable since it calls for "prices useful for billing purposes" in the combination of claim 33.

Claim 40 is patentable since it calls for "takes a picture" in combination of claim 28.

Claim 41 is patentable since it calls for "taking a picture" in the combination of claim 33.

Claims 42-45 are patentable since they require entry of the operations into computer memory before the machine completes its function. Dorne does not enter his second entry until after the function is performed.

Claim 46 is patentable since it deals with a double checking the work of operation of a medical machine whereas Dorne deals only with the end results and not to operations of a machine that produces a result.

Respectfully,



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